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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,850	02/04/2002	Ilya Avrutov	1662/55702	5145

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KENYON & KENYON  
ONE BROADWAY  
NEW YORK, NY 10004

EXAMINER

ROBINSON, BINTA M

ART UNIT PAPER NUMBER

1625

DATE MAILED: 08/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/066,850

Applicant(s)

AVRUTOV ET AL.

Examiner

Binta M. Robinson

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8, 10, 13-21 and 25-28 is/are rejected.
- 7) ☒ Claim(s) 4-7, 9, 11, 12 and 22-24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### Detailed Action

Claim 8 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In claim 8, line 2, page 17, the term "hydroperoxide" is indefinite because it is misspelled.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16-18, 20, 25-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. *keep* A. In claims 16-18, line 1, the term "Oxone" because it is a trade name.
- B. In claim 20, line 2, page 17, the phrase "any one or more of acetone and methanol" is indefinite. It is unclear as to what the phrase "any one or more" is referring to.
- C. In claims 25-28, line 1, page 18, the phrase "substantially free" is indefinite. The term "substantially" renders the term "free" indefinite. The term "substantially" is ambiguous and vague.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

✓ Claim(s) 25-28 are rejected under 35 U.S.C. 102(b) as being anticipated by

121 may. Linder et. al. (See Reference N) Linder et. al. discloses the instant compounds, Omeprazole, lansoprazole, and rabeprazole. At pages 1-14, see the instant compound

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

✓ (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 8, 10, 13, 14, 15, 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandstram et. al.. (See Reference A ).

Brandstram et. al. teaches the instant process as shown in column 59, lines 44-67 where the compound of Formula I is synthesized, where R1, R2, R3, R4, R5, R6, and R7 are hydrogen, hydrogen or CF3, R15 is hydrogen and X is S. At column 59, see the process of forming the compound of formula I. The difference between the prior art compound and the instantly claimed compounds is the teaching of a generic compound versus a disclosed species. It would have been obvious to one of ordinary skill in the art to select various known radicals within a genus to prepare structurally similar compounds. Accordingly, the compounds are deemed unpatentable therefrom in the

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absence of a showing of unexpected results for the claimed compounds over those of the generic prior art compounds.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

✓ (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brennan et. al.. (See Reference O).

Brennan et. al. teaches the instant process as shown at page 11, claim 1, where the compound of formula I where  $R_1=CH_3$ ,  $R_2 = OCH_3$ ,  $R_3 =CH_3$ ;  $R_4=OCH_3$  or  $R_1 = CH_3$ ;  $R_2 = OCH_2CF_3$ ;  $R_3 = H$ ;  $R_4=H$  or  $R_1 = OCH_3$ ;  $R_2 = OCH_3$ ;  $R_3= H$ , and  $R_4=OCHF_2$  is formed by reacting the compound of formula II where the radicals  $R_1$ - $R_4$  are as defined for the compound of formula I, and is reacted with a perborate salt in a liquid diluent at a pH in the range of 7.5 to 14 at a temperature in the range of 0 degrees Celsius to the boiling point of the liquid diluent employed. At page 11, see Brennan process. The difference between the prior art compound and the instantly claimed compounds is the teaching of a generic compound versus a disclosed species. It would have been obvious to one of ordinary skill in the art to select various known radicals within a genus to prepare structurally similar compounds. Accordingly, the compounds are deemed

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unpatentable therefrom in the absence of a showing of unexpected results for the claimed compounds over those of the generic prior art compounds.

Claims 5-7, 9, 11, 12, 22-24 are objected to because they are based on a rejected claim.

The IDS at paper no. 4 has been considered. The references that have been crossed out will not be considered until provided to the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is (703) 306-5437. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on (703)308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-7922 for regular communications and (703)308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0193.

Binta Robinson

August 11, 2002

*Alan L. Rotman*

ALAN L. ROTMAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600